

that previous amendments necessitated a new ground for rejection and thus justified placing the case under final rejection, Applicant contends that the rejection would have been at least as applicable to the prior claims as to the presently pending claims and, thus, the new basis for rejection should have prevented the case from being finally rejected. Nevertheless, Applicant argues below why the present claims should be allowable over the new combination proposed by the Examiner.

The Examiner conceded that Sonoda doesn't show the barrel portion having a generally squared shoulder disposed around a portion of the cylindrical barrel portion such that a cross section of the barrel portion taken at the carrier strip includes a generally round portion not adjacent the carrier strip and a generally squared portion adjacent the carrier strip, the squared shoulder facilitating cutting the terminal completely from the carrier strip. He then stated, however, that Thillays discloses the concept of having a generally squared shoulder, the squared shoulder facilitating cutting the photo conductors completely from the carrier strip. He further stated that it would have been obvious to one of ordinary skill in the art to modify the terminal of Sonoda by including the generally squared shoulder taught by Thillays.

In fact, the proposed combination does not yield the claimed invention. In part because the Thillays reference relates to entirely different subject matter, namely a method of manufacturing a coplanar photo coupler comprising a light emitter and a photo sensitive receiver which are coupled by an optical element, the supposed squared shoulder (6) of Thillays has no function similar to that in the claimed invention relative to

cutting a terminal completely from a carrier strip. While the Examiner claimed that the squared shoulder (6) facilitates the cutting of the photo conductors (1) completely from the carrier strip, FIG. 4 of the reference and the textual description thereof do not support this claim. As indicated in column 3, lines 6-10, of the Thillays reference, the Thillays method involves a fine tip (10) provided on the rear face of a flexible disc (7) so as to lift an element (5) which then detaches from the disc (7). Simultaneously, the element (5) is attracted by the vacuum pick-up (11). Thus, there is nothing in Thillays to suggest that the squared shoulder (6), as the Examiner identified it, facilitates cutting photo conductors from any carrier strip. Assuming that the Examiner is analogizing a carrier strip to the disc (7), from which the photo conductor element (5) is removed, there is no cutting at all, much less any cutting device directed at the squared shoulder for better or complete severance as is shown in the claimed invention. Thus, even if the prior art somehow suggested the propriety of combining the Thillays reference with the Sonoda reference, it would not teach modification of the Sonoda reference in the manner that the Examiner has suggested to achieve the claimed invention.

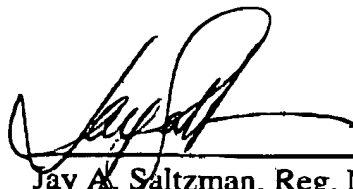
Additionally, the Examiner has failed to indicate any suggestion in the art to combine these two references. Especially given how far afield the subject matter of the Thillays reference is from the technology of cutting terminals from a carrier strip, the Examiner has failed to identify any motivation in the art to combine these references. When relying on numerous references or a modification of prior art, it is incumbent upon the Examiner to identify some suggestion to combine references or make modification.

In re Mayne, 104 F.3d 1339, 41 USPQ. 2d 1451 (Fed.Cir. 1997). The Examiner has not identified that suggestion within the references or the art generally, and it is therefore inappropriate to combine these references.

Thus, the combination of references proposed by the Examiner is both not suggested by the prior art and fails to teach the claimed invention. Thus, Applicant suggests that currently pending claims 1-6 are allowable.

As the Examiner did not comment in the above-identified Office Action on the proposed drawing correction submitted with the prior Reply, Applicant assumes that the Examiner agreed that the corrected drawings are in compliance with MPEP §608.02(g).

Respectfully submitted,



Jay A. Saltzman, Reg. No. 38,293
Attorney for Applicant

Date: June 23, 2003

Panduit Corp.
Legal Dept. - TP12
17301 S. Ridgeland Ave.
Tinley Park, Illinois 60477
(708)532-1800, x1302

FAX RECEIVED

JUN 23 2003

TECHNOLOGY CENTER 2800